

U.S. Serial No.: 09/482,235
Docket No. 26068-05E

Examiner: Brenda Coleman
Art Unit: 1624

REMARKS

Claims 3-5, 8-11, 13-16, 19-24, and 28-41 are currently pending in this application.
Claims 26 and 27 have been canceled and new claims 28-41 have been added.

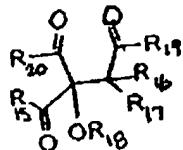
Applicants note with appreciation the courtesy extended by the Examiner in a telephone interview on May 4, 2005 to discuss the patentable features of the invention.

Reconsideration and withdrawal of the rejections of all of the claims of the application in view of the amendments made above and the remarks to follow is respectfully requested.

Prior to discussing the substantive rejections, Applicants take this opportunity for the convenience of the examiner to explain the scope of the amendments and newly added claims.

Specifically, independent claims 26 and 27 have been repeatedly rejected as not being supported by Applicants' provisional and PCT applications. To this end, Applicants have canceled claim 26 and in its place, submit new independent claim 28. Claim 28 is similar in scope to claim 26, but there are two notable differences:

1) The structure has been removed as an alternative to the



claimed acetal structure; and

2) The nomenclature of R has been more specifically defined as R₁-R₂₀, as explicitly described in Applicants' provisional application.

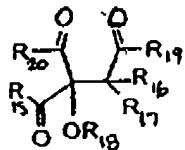
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In a similar manner, cancelled claim 27 has been redrafted as independent claim 30 with the same respective changes as set forth above for claim 28.

As will be explained in greater detail below, Applicants respectfully submit that newly submitted claims 28 and 30 are explicitly disclosed in the present application and in all of the intervening applications back to and including the provisional application.

Additionally, to further define the claimed invention, new independent claims 29 and 31 are also submitted herein for consideration. Specifically, independent claim 29 tracks the subject matter of new independent claim 28, with one change – the structure of the acetal has been provided in the form of its open chain congener:



The open chain congener of the acetal is specifically described in the present application and in all of the intervening applications, back to and including the PCT application. While Applicants acknowledge that the open chain congener is not explicitly provided for in the provisional application, Applicants respectfully submit that a person of ordinary skill in the art would know that the open chain congener of the acetal may be readily used in place of the acetal and that the provisional application would thus provide support for the acetal as well as its open chain congener.

Newly added independent claim 31 tracks the language of cancelled claim 27, including the changes noted above for claim 30. In addition, and in a similar manner to claim 29, the structure of the acetal has been provided in the form of its open chain congener.

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Lastly, new independent claims 40 and 41 have been added to define R₁-R₂₀ more broadly as set forth in the provisional application. Applicants respectfully submit that the present application, and all of the intervening application back to and including the provisional application, provide for defining R₁-R₂₀ in the manner claimed as set forth in more detail below.

Applicants now turn to what Applicants believe is the main outstanding rejection, namely whether the claims, as now amended, are fully supported by the present application as well as all of the intervening applications back to and including the provisional application. Applicants respectfully submit that they are.

Specifically, Applicants refer to the provisional application, the international "PCT" application, and the present application, which is a CIP of the PCT application. Applicants respectfully submit that explicit support exists for all of the subject matter set forth in the claims in the present application and in all of the intervening applications back to and including the provisional application. That is, although Applicants acknowledge that the provisional application uses slightly different nomenclature (e.g., R₁-R₂₀) as compared to the PCT application and the present application, Applicants respectfully submit that a person of ordinary skill in the art could easily discern that the compounds are the same, even though different nomenclature may be used.

For example, taking first the subject matter of independent claim 28, the indolocarbazole is described in the present application at page 14, in the PCT application at page 11, and in the provisional application at pages 11 and 78. In addition, while the present claims contain the nomenclature for R₁-R₂₀ as specifically set forth in the provisional application, it can be readily ascertained that the compounds described are the same. The acetal is described in the present application at page 14, in the PCT application at page 11, and in the provisional application at pages 12 and 81. The furanosylated product is described in the present application at page 16, in the PCT application at page 13, and in the provisional application at pages 12 and 81.

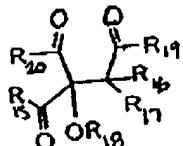
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Turning next to independent claim 30, the diazo is described in the present application at page 14, in the PCT application at pages 11 and 12, and in the provisional application at pages 11 and 78, and the biindole is described in the present application at page 14, in the PCT application at page 14, and in the provisional application at pages 10 and 78. The remaining elements of the claim are the same as in claim 28 and support for these elements is discussed above.

Support for dependent claim 8 can be found in the present application at page 16, in the PCT application at page 13, and in the provisional application at page 12.

Independent claims 29 and 31 provide for the open chain congener of the acetal having the ring structure



As such, these claims are not explicitly provided for in the provisional application, but are described in both the PCT application and the present application. Applicants respectfully submit that a person of ordinary skill in the art would know that the open chain congener of the acetal may be readily used in place of the acetal and that the provisional application would thus provide support for the acetal as well as its open chain congener. However, if the Examiner takes the position that the open chain congener is distinct from the acetal and is not supported by the provisional, Applicants respectfully submit that the prior art cited (Woods et al., Tetrahedron Letters and Woods et al., Journal of American Chemical Society) cannot be sustained against these claims as neither of the cited references describe the open chain congener of the acetal.

Independent claims 40 and 41 are similar in scope to independent claims 28 and 30 but define values for R₁-R₂₀ in a different manner. Support for the definition of the R

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values for claims 40 and 41 can be found in the provisional application at pages 75-83 in the paragraph entitled "Alternative Procedures." The PCT application defines R as representing a "substituent comprised of any number and combination of the elements H, C, H, S, Si, O, Cl, Br, I, and F," which would thus be inclusive of the R values defined in the provisional application. The present application further defines R on pages 3-5 as comprising various R groups listed. Thus, it can be seen that the present application and all of the intervening applications back to and including the provisional define R in a manner that is covered by claims 40 and 41.

Next, Applicants address in turn each of the issues raised by the Examiner in her Advisory Action.

With respect to ¶¶1 and 2 of the Advisory Action, the Examiner maintained her rejection of the claims as being anticipated by Wood et al., Tetrahedron Letters or Woods et al., Journal of American Chemical Society. Applicants believe that the discussion provided above demonstrates that the instant claims are fully supported by the present application as well as all of the intervening applications back to and including the provisional application and respectfully request reconsideration and withdrawal of the rejection of the claims as being anticipated by Woods et al., Tetrahedron Letters or Woods et al., Journal of American Chemical Society.

With respect to ¶3, Applicants believe that the claims, as amended, are fully supported by the present application as well as all of the intervening applications back to and including the provisional application, in such a way as to convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. If the Examiner believes otherwise, it is respectfully requested that such rejections be clearly explained so that Applicants can address any outstanding issues remaining.

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Finally, as set forth in detail in Applicants' response filed on November 9, 2004, Applicants respectfully submit that the present application is entitled to claim priority all the way back to the provisional application as all of the requirements set forth in M.P.E.P. §201.11 have been met. Applicants respectfully direct the Examiner's attention to the discussion of the priority claim set forth in the November 9, 2004 response, which is incorporated by reference herein, and add the following supplemental comments:

Applicants note that 35 U.S.C. 120 provides a benefit of an earlier filing date in the United States for an application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 or as provided by section 363. Section 363 in turn provides that “[a]n international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office...”.

The present application and all of the intervening applications each contain a statement incorporating by reference the disclosure of all of the earlier filed applications, and therefore implicitly contain the description of the invention set forth in all of the intervening applications back to the provisional application. Section 120 does not place any restriction or limitation as to how the now claimed invention must be disclosed in the earlier application to comply with the first paragraph of section 112.

Applicants respectfully submit that they have met all of the conditions for priority set forth in 35 U.S.C. §§119(e) and 120. Because the instant application has met all of the conditions for obtaining the benefit of the provisional application, Applicants respectfully submit that the present application is entitled to the benefit of the August 11, 1995 priority date.

CONCLUSION

Applicant believes that the foregoing is a full and complete response to the Office Action of record. Accordingly, an early and favorable reconsideration of the rejection of

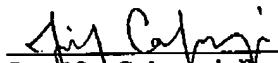
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all of the claims is requested. Applicants believe that claims 3-5, 8-11, 13-16, 19-24, and 28-41 are now in condition for allowance and an indication of allowability and an early Notice of Allowance is respectfully requested.

If Examiner feels that a telephonic interview would be helpful, she is requested to call the undersigned at (203) 575-2648.

Respectfully submitted,



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